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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------------|------------------|
| 09/543,938 | 04/06/2000 | Dushyant Sharma | 39440/199992 | 7936 |
| 22922 | 7590 | 09/30/2005 | EXAMINER BACKER, FIRMIN | |
| REINHART BOERNER VAN DEUREN S.C. ATTN: LINDA GABRIEL, DOCKET COORDINATOR 1000 NORTH WATER STREET SUITE 2100 MILWAUKEE, WI 53202 | | | ART UNIT 3621 | |

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/543,938

Applicant(s)

SHARMA, DUSHYANT

Examiner

FIRNM BACKER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-10,13,17,22-30,32-34,39,41-43,50 and 82-97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-10,13,17,22-30,32-34,39,41-43,50 and 82-97 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 2-10, 13, 17, 22-30, 32-34, 39, 41-43, 50 and 82-97 are rejected under 35

U.S.C. 102(e) as being anticipated by Savage et al (U.S. PG Pub No 2002/0026394).

3. As per claims 82 and 88, Savage et al teach an electronic bill presentment and payment system for presenting and paying bills via an electronic data network, comprising an input processing functionality adapted to receive billing data from a plurality of billers in a plurality of different billing data forms a parsing functionality adapted to parse the billing data received from the plurality of billers in a plurality of different billing data forms to transform the billing data into a common document model wherein the transformed billing data is all of the same form a database adapted to store the transformed billing data parsed by the parsing functionality presentation functionality coupled to the database and adapted to retrieve transformed billing data from the database and to output at least some of the retrieved transformed billing data via the electronic data network for use by bill payers; and biller interactivity functionality coupled to

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the database and adapted to allow the plurality of billers individually to retrieve and review transformed billing data from the database and to after the transformed billing data in the database (*see figs 1, 2, 3, 6, 8, 2.3, 30 paragraphs 0003, 0004, 0013, 0015, 0018, 0021, 0023, 0054, 0055, 0058*).

4. As per claims 2-4, Savage et al teach a system wherein the parsing functionality is adapted to parse data from a print/interchange/financial stream of data provided by a biller (*see figs 1, 2, 3, 6, 8, 2.3, 30 paragraphs 0003, 0004, 0013, 0015, 0018, 0021, 0023, 0054, 0055, 0058*).

5. As per claims 5-9, Savage et al teach a system wherein the presentation functionality is adapted to output transformed billing data for use by the bill payers using style sheet in order to render transformed billing data is a suitable form using markup language, is adapted to output transformed billing data for use by bill payers using or not financial software or browser (*see figs 1, 2, 3, 6, 8, 2.3, 30 paragraphs 0003, 0004, 0013, 0015, 0018, 0021, 0023, 0054, 0055, 0058*).

6. As per claims 10, 50, Savage et al teach a system for presenting and paying bills comprising interactivity functionality to detect and respond to communication from bill payers by retrieving transformed billing data from the database and presenting it to a payer in a form requested by the bill payer, and altering transformed billing data in the database corresponding to the bill payer according to the communications (*see figs 1, 2, 3, 6, 8, 2.3, 30 paragraphs 0003, 0004, 0013, 0015, 0018, 0021, 0023, 0054, 0055, 0058*).

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7. As per claims 17, Savage et al teach a system for presenting and paying further comprising a financial source interface adapted to send and receive communication to and from at least one financial entity and to alter transformed billing data in the database according to the financial source communications (*see figs 1, 2, 3, 6, 8, 2.3, 30 paragraphs 0003, 0004, 0013, 0015, 0018, 0021, 0023, 0054, 0055, 0058*).

8. As per claims 22-24, Savage et al teach a system wherein the billing data is extracted from a print/interchange/financial stream of data provided by a plurality of billers (*see figs 1, 2, 3, 6, 8, 2.3, 30 paragraphs 0003, 0004, 0013, 0015, 0018, 0021, 0023, 0054, 0055, 0058*).

9. As per claims 25-29, Savage et al teach a system wherein some transformed billing data is output using the bill payers using style sheet in order to render transformed billing data is a suitable form using markup language, is adapted to output transformed billing data for use by bill payers using or not financial software or browser (*see figs 1, 2, 3, 6, 8, 2.3, 30 paragraphs 0003, 0004, 0013, 0015, 0018, 0021, 0023, 0054, 0055, 0058*).

10. As per claims 30-33, Savage et al teach a system further comprising detecting and responding to communication from bill payers by retrieving transformed billing data from the database and presenting it to a payer in a form requested by the bill payer; and altering transformed billing data in the database corresponding to the bill payer according to the

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communications (*see figs 1, 2, 3, 6, 8, 2.3, 30 paragraphs 0003, 0004, 0013, 0015, 0018, 0021, 0023, 0054, 0055, 0058*).

11. As per claims 34, Savage et al teach a system wherein the interface is adapted t allow bill payers to specify the location of the output (*see figs 1, 2, 3, 6, 8, 2.3, 30 paragraphs 0003, 0004, 0013, 0015, 0018, 0021, 0023, 0054, 0055, 0058*).

12. As per claims 41-43, Savage et al teach a system wherein the biller interface is adapted to allow the plurality of billers to alter the appearance bill presentment and to communicate with payers based on market segments (*see figs 1, 2, 3, 6, 8, 2.3, 30 paragraphs 0003, 0004, 0013, 0015, 0018, 0021, 0023, 0054, 0055, 0058*).

13. As per claims 83-87, and 89-97, they are dependent on claims 82 and 88 and contain that do not further limit the scope of the disclosure. Therefore, they are rejected under the same rationale as claims above

Response to Arguments

14. Applicant's arguments filed July 21st, 2005 have been fully considered but they are not persuasive.

a. Applicant essentially argues that the prior art fail t teach an inventive concept of receiving billing data from a plurality of biller in a plurality of different forms and

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parsing such data into a common model wherein the transformed billing data is all the same form. Examiner respectfully disagrees with Applicant characterization of the prior art. Savage et al teach a computerized method and system of *combined billing which enables the billing of multiple product lines on a single statement*. Savage et al concept allowed all types of utilities, such as telephone, energy, water, gas, cable, and home security to be combined in to one billing. The concept provides a tremendous convenience to the consumer, for example, the ability to receive multiple statements in a single envelope with multiple payment options or reward propositions. At the same time, it provides valuable cost advantages, for example, to these utilities. Further, processing cost (i.e., the cost for processing the payment), statement delivery costs, collections cost, credit warehousing and data cost, and management and system infrastructure cost are leveraged across a wide array of services. Savage et al does not explicitly disclose that the received bills are in different format. However. It is obvious that the bills are not from the same company and are therefore in different format since each company uses their own format to prepare customer invoice. For the reason above the rejection is sustained.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

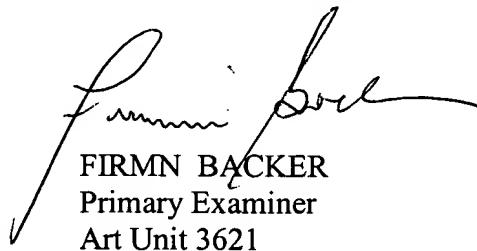
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FIRMN BACKER whose telephone number is 571-272-6703. The examiner can normally be reached on Monday - Thursday 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


FIRMN BACKER
Primary Examiner
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September 27, 2005